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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/692,321
Filing Date: October 22, 2003
Appellant(s): MONK, SIMON

Lee W. Tower
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/06/2011 appealing from the Office action mailed 01/19/2011.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 25-37.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

2002/0091550	White et al.	07-2002
2001/0037265	Kleinberg	11-2001
6,341,265	Provost et al.	01-2002
6,070,148	Mori et al.	05-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 25-27 and 37 are rejected under 35 U.S.C. 102(e) as being taught by White et al. (U.S. Publication No. 2002/0091550).

3. As per claim 25, White teaches a computer system for providing a travel insurance product via an electronic network comprising:

a computer server system, the server system including,

-a verification routine arranged to receive an identification request sent from a subscriber via the electronic network to the server system to verify the subscriber (**White: figure 2; para. 95**),

-a receiving module arranged to receive a subscriber request sent via the electronic network for the travel insurance product (**White: figure 2; para. 95**),

-a pricing module arranged to compute a price for the travel insurance product requested by the subscriber utilizing an object model stored in a database implemented on the computer server system modeling the travel insurance product as issued to the subscriber, the model having a plurality of attributes of a product, wherein the model enables a combination of the attributes to be created, the combination arranged to determine the price for the travel insurance product (**White: para. 122; 131-132; para. 155-165**),

-a payment module arranged to communicate the price to the subscriber and receive payment details from the subscriber via the electronic network to execute payment via electronic transfer, and whereupon payment has been executed (**White: para. 95; 126-127**),

-an issuing component arranged to issue the insurance product to the subscriber and update the object model (**White: para. 95**), characterized in that the issuing component of the server system, in response to a further subscriber request, allows the subscriber to vary at least one term

of the issued travel insurance product via the electronic network by adjusting the combination of attributes through an electronic interface (**White: para. 122-123; 140; para. 153; para. 183**).

4. As per claim 26, the system of claim 25 is as described. White further teaches further comprising: a client system having an interface that prompts information from the subscriber wherein the information sent to the server system via the electronic network includes at least one of verifying the subscriber, requesting an insurance product and submitting details for payment (**White: figure 4; para. 95; 122-123; 126-127; 131-132; 140; para. 153**).

5. As per claim 27, the system of claim 26 is as described. White further teaches wherein the system further includes a telecommunication module arranged to transmit the information between the client system and the server system (**White: para. 97-103**).

6. As per claim 37, it is a method claim which repeats the same limitations of claim 25, the corresponding system claim, as a series of process steps as opposed to a collection of elements. Since the teaching of White discloses the structural elements that constitute the system of claim 25, it is respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claim 37 are rejected for the same reasons given above for claim 25.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265).

9. As per claim 28, the system of claims 26 or 27 is as described. White does not teach further comprising a database that includes at least one table of data, wherein the information obtained from the subscriber is utilised to locate a value in the at least one table of data, the value being the purchase cost of the insurance product.

Kleinberg teaches further comprising a database that includes at least one table of data, wherein the information obtained from the subscriber is utilised to locate a value in the at least one table of data, the value being the purchase cost of the insurance product (**Kleinberg: para. 0039-0040; figure 3**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White and Kleinberg with the motivation that insurance policies respond to different customer description data and therefore help customers by providing a preferential ranking of quotes that could be used for insurance (**Kleinberg: para. 0020**).

10. As per claim 29, the system of claim 28 is as described. White does not teach wherein the database includes a first and a second table, the first table being utilized to calculate the cost to the subscriber when the subscriber is issued with the insurance product, and the second table being utilized to calculate the cost to the subscriber when the subscriber varies the at least one term in the insurance product.

Kleinberg teaches wherein the database includes a first and a second table, the first table being utilized to calculate the cost to the subscriber when the subscriber is issued with the insurance product, and the second table being utilized to calculate the cost to the subscriber when the subscriber varies the at least one term in the insurance product (**Kleinberg: para. 0039-0040; figure 3**).

The motivation to combine the teachings is the same as claim 28.

11. As per claim 30, the system of claim 29 is as described. White further teaches comprising authenticating module to authenticate the subscriber before obtaining information from the subscriber (**White: figure 2; para. 95**).

12. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265) and further in view of Provost et al. (U.S. Patent No. 6,341,265).

13. As per claim 31, the system of claim 30 is as described. White and Kleinberg do not explicitly teach wherein the client system further includes a claims interface to prompt a subscriber to provide claim information, the claim information being compared with a predetermined rule set contained within the database, to determine whether the subscriber is entitled to receive compensation for the claim.

Provost teaches wherein the client system further includes a claims interface to prompt a subscriber to provide claim information, the claim information being compared with a predetermined rule set contained within the database, to determine whether the subscriber is entitled to receive compensation for the claim (**Provost: figure 3 & 4B**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White, Kleinberg, and Provost with the motivation that careful review of payment requests minimizes fraud and unintentional errors and provides consistency of payment (**Provost: col. 1, 31-38**).

14. As per claim 32, the system of claim 31 is as described. White and Kleinberg do not explicitly teach wherein the server system includes an interface which communicates the claim information to an insurance underwriter for further processing.

Provost teaches wherein the server system includes an interface which communicates the claim information to an insurance underwriter for further processing(**Provost: col. 1, 64 to col. 3, 13**).

The motivation to combine the teachings is the same as claim 31.

15. As per claim 33, the system of claim 32 is as described. White does not teach wherein the at least one term of the insurance product is the time period for which the insurance product is valid.

Kleinberg teaches wherein the at least one term of the insurance product is the time period for which the insurance product is valid (**Kleinberg: para. 0038**). The examiner interprets that the length of trip is the same as time period for which the insurance product is valid.

The motivation to combine the teachings is the same as claim 1 and 31.

16. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265)

and further in view of Provost et al. (U.S. Patent No. 6,341,265) and Mori et al. (U.S. Patent No. 6,070,148).

17. As per claim 34, the system of claim 32 is as described. White, Kleinberg, and Provost do not explicitly teach wherein the at least one term of the insurance product is the intended destination of the subscriber.

Mori teaches wherein the at least one term of the insurance product is the intended destination of the subscriber (**Mori: figure 14**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White, Kleinberg, Provost, and Mori with the motivation to provide an electronic commerce system in which information concerning a commodity or service can be provided to a user in a suitable timing (**Mori: col. 2, 44-53**).

18. As per claim 35, the system of claim 34 is as described. White, Kleinberg, and Provost do not explicitly teach wherein the at least one term of the insurance product is the total coverage value of the insurance policy.

Mori teaches wherein the at least one term of the insurance product is the total coverage value of the insurance policy (**Mori: figure 14 & 15**).

The motivation to combine the teachings is the same as claim 34.

19. As per claim 36, the system of claim 35 is as described. White, Kleinberg, and Provost do not explicitly teach wherein the insurance product is travel insurance.

Mori teaches wherein the insurance product is travel insurance (**Mori: figure 14 & 15**).

The motivation to combine the teachings is the same as claim 34.

(10) Response to Argument

Issue 1: Claims 25-27 and 37 rejected under 35 U.S.C. 102(e) over White et al. (U.S. Publication No. 2002/0091550).

Appellant argues that White does not disclose an “object model...modeling the travel insurance product as issued to the subscriber.” Examiner disagrees with the Appellant. An object model according to the appellant is a "model that defines a relationship between insurance products, policies sold to subscribers for those products and the extensions and claims for each policy." White teaches creating a pricing from the base rate created by the system from the information gathered from previous policy data (para. 111) and dynamic pricing tier that has been gathered to form base rates from different insurance policies (para. 180); therefore teaching a system that combines different information (i.e. attributes) about a consumer to determine the price of an insurance product.

Appellant argues that there is no teaching or suggestion in White that dynamic pricing “allows the subscriber to vary at least one term of the issued travel insurance product.” Examiner disagrees with the Appellant. White teaches the dynamic pricing to be run on a periodic basis to generate rate change based on changes in customer demand (i.e. term change); if a customer has an offer already in the data base, then the previous offer is updated instead of creating a new offer. When a customer wants (i.e. customer demand) to vary at least one term of the issued travel insurance product, the system searches a previous offer and uses it as the newly generated offer including the varying term (para. 155-158).

Issue 2: Claims 28-30 rejected under 35 U.S.C. 103(a) over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265).

Appellant argues that Kleinberg does not teach or suggest "the second table being utilized to calculate the cost to the subscriber when the subscriber varies the at least one term in the insurance product." Examiner disagrees. Kleinberg teaches different tables within a database, wherein each table held different attributes, which one of them included a policy term; therefore, when a user uses the system of Kleinberg, they are able to vary the term and compare prices for different variance.

Issue 3: Claims 31-33 rejected under 35 U.S.C. 103(a) over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265) and further in view of Provost et al. (U.S. Patent 6,341,265).

Appellant argues the automation part of claim 31 that Provost is silent of an automatic system. Examiner states that in the case law of *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Issue 4: Claims 34-36 rejected under 35 U.S.C. 103(a) over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265) and further in view of Provost et al. (U.S. Patent 6,341,265) and Mori et al. (U.S. Patent No. 6,070,148).

Appellant argues that Mori is not directed to an insurance system but rather to a system for recording information with regard to business expenses. Examiner disagrees. Mori uses an insurance business as an example throughout the invention and furthermore figure 14 provides an input system for searching for a travel insurance product; the user puts in different attributes (i.e. destination, duration, etc.) and the system searches for the best travel insurance product. In response to appellant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, Mori was combined to insert the teaching of duration of a travel insurance product to systems that already teach travel insurance.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/SHEETAL R RANGREJ/

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